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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,213	12/05/2003	Peter G. Klimko	2444 US	9504
7590		05/10/2007		
Teresa J. Schultz				
Alcon Research, Ltd.				
6201 South Freeway, Q-148				
Fort Worth, TX 76134-2099				
EXAMINER				
RAMACHANDRAN, UMAMAHESWARI				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
05/10/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,213	<b>Applicant(s)</b> KLIMKO ET AL.	
	<b>Examiner</b> Umamaheswari Ramachandran	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The examiner notes the receipt of the amendments and remarks received in the office on 3/15/2007 amending claim 1. Claim 1 is pending.

The rejection of claim 1 under 35 U.S.C 102(a) is withdrawn due to the amendment of claim 1. The rejection of claim 1 under 35 U.S.C 103(a) is withdrawn due to the amendment of claim 1. Further consideration and additional search necessitated the following rejections.

#### ***Claim Rejections - 35 USC § 102***

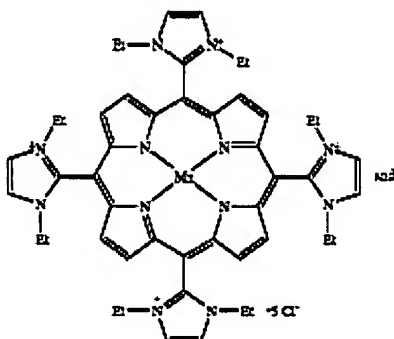
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Crapo et al. (US 6,544,975).

Crapo et al. teach the compound of formula I (figure 1c). The reference further teaches that the compound can be used for the treatment of glaucoma, cataract and macular degeneration of the eye (col. 8, lines 15-20).



(Formula I)

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Crapo et al. (US 2004/0023941).

Crapo et al. teach the compound of formula I, as above (p 29). The reference further teaches that the compound can be used for the treatment of glaucoma, cataract and macular degeneration of the eye (p 5, para 0047),

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crapo et al. (US 6,544,975) in view of Kato et al. (U.S. 5,665,769).

Crapo et al.'s teachings discussed as above. The reference do not teach a method of treating retinal edema with compound of formula I.

Kato et al. teach macular degeneration and retinal edema as retinal diseases (col. 1, lines 10-40).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to use compound of formula I in the treatment of retinal edema. The motivation to do so is provided by Crapo and Kato et al. Crapo teaches the compound of formula (I) in a method of macular degeneration and Kato et al. teaches that retinal edema and macular degeneration are both retinal diseases. Hence one of ordinary skill in the art at the time of the invention would have been motivated to use the compound of formula I in the treatment of retinal edema as the compound has been shown to be successful in the treatment of another retinal disorder.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crapo et al. (US 2004/0023941) in view of Kato et al. (U.S. 5,665,769).

Crapo et al.'s teachings discussed as above.

The reference do not teach a method of treating retinal edema with compound of formula I.

Kato et al. teach macular degeneration and retinal edema as retinal diseases (col. 1, lines 10-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use compound of formula I in the treatment of retinal edema. The motivation to do so is provided by Crapo and Kato et al. Crapo teaches the compound of formula (I) in a method of macular degeneration and Kato et al. teaches that retinal edema and macular degeneration are both retinal diseases. Hence one of ordinary skill in the art at the time of the invention would have been motivated to use the compound

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of formula I in the treatment of retinal edema as the compound has been shown to be successful in the treatment of another retinal disorder.

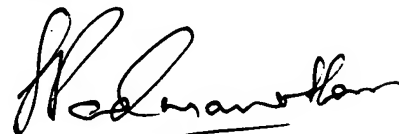
### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**SREENI PADMANABHAN**  
SUPERVISORY PATENT EXAMINER